

REMARKS

Claims 1-19 were pending, of which: claims 2, 6, 11 and 15 stand rejected under 35 USC § 112 ¶ 2; and claims 1-19 stand rejected under 35 U.S.C. 102(a). In this Amendment, the Specification is amended to correct a typographical error; and claims 2-3, 6, 11 and 16 are amended. No new matter is added. Claims 1-19 remain pending in the present application. In addition, Applicant submits the following remarks.

Rejection Under 35 USC § 112 ¶ 2.

Claims 2-3, 6 and 11 are rejected under 35 U.S.C. 102(a) as being indefinite; specifically, the phrase “opposed sides” in the rejected claims is deemed indefinite in view of there being a pair of opposed sides identified in the specification. Applicant amends the claims to make clear that the “opposed sides” recited in the subject claims refers to the “first pair of opposed sides”. Claims 2, 6 and 16 further are amended to correct an antecedent basis informality. No new matter is added. Applicant submits that one of ordinary skill would understand that “the first pair of opposed sides”, as recited, refers to the long sides of the optical window; this meaning is borne out by the Specification, and specifically at page 2, lines 29-31; page 3, lines 14-18; and page 4, lines 6-11.

Rejection Under 35 USC § 102(a).

Claims 1-19 are rejected under 35 U.S.C. 102(a) as being anticipated by Applicant Admitted Prior Art (“AAPA”). The Examiner bases the § 102(a) rejection on Applicant’s specification, which discloses “a typical optical wheel in an optical mouse of the prior art.” However, the Examiner concedes that the AAPA fails to disclose a prior art device having optical windows characterized by a substantially hourglass shape. The missing teaching is asserted by the Examiner to be supplied by In re Dailey, 149 USPQ 47 (CCPA 1966). Applicant respectfully traverses the rejection.

In re Dailey is summarized thus the MPEP 2144.04(IV)(b) as “The court held that the configuration of the claimed disposable plastic nursing container was a matter of choice which a person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration of the claimed container was significant” (underline added). Dailey is deemed applicable when the facts in that case are sufficiently similar to those in the present application:

2144.04 Legal Precedent as Source of Supporting Rationale [R-1]

As discussed in MPEP § 2144, if the facts in a prior legal decision are sufficiently similar to those in an application under examination, the examiner may use the rationale used by the court.... If the applicant has demonstrated the criticality of a specific limitation, it would not be appropriate to rely solely on case law as the rationale to support an obviousness rejection. (MPEP 2144.04)

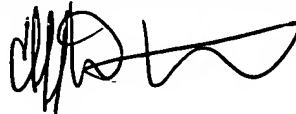
The facts of Dailey can be readily distinguished from the present application, in that Applicant has included in the specification persuasive evidence that the particular configuration of the claimed optical window is significant. The specification discusses the shortcomings of a prior art "straight-sided windows" optical wheel. (Specification, page 2, lines 23-27 ("In the computer mouse example, this non-uniform light then passes through straight-sided apertures 22 in the signal-generating wheel 20 (FIG. 2). The resultant waveform does not present a square shape, thereby introducing inaccuracy into the device and necessitating additional processing to correct for the waveform imperfection.") (underline added)).

Applicant discloses the claimed "hourglass-shaped" optical window structure (page 2, line 29), the function and benefit of which is subsequently discussed at page 3, lines 1-8. The limitation of hourglass-shaped optical windows appears in all pending claims, including all independent claims. The structure of the claimed optical window is a specific limitation, the criticality of which has been demonstrated in the disclosure.

For the foregoing reasons, reconsideration and allowance of claims 1-19 of the application as amended is solicited. The Examiner is encouraged to telephone the undersigned at (503) 222-3613 if it appears that an interview would be helpful in advancing the case.

Respectfully submitted,

MARGER JOHNSON & McCOLLOM, P.C.



Cliff D. Weston
Reg. No. 48,307

MARGER JOHNSON & McCOLLOM, P.C.
1030 SW Morrison Street
Portland, OR 97205
503-222-3613
Customer No. 20575

